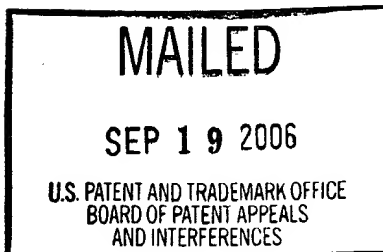


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte RAJEEV GROVER, DOUGLAS W. ARENS, and KEVEN PAUL MORLANG



Appeal No. 2006-2460
Application No. 09/966,620

ON BRIEF

Before HAIRSTON, JERRY SMITH, and RUGGIERO, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-7, 9, 10 and 12-23.

The disclosed invention pertains to a method and apparatus for configuring a network parameter to a device.

Representative claim 1 is reproduced as follows:

1. A method for configuring a first parameter to a first device,

comprising the steps of:

- providing a network communication channel connected to the first device and to a configuring machine;
- from the configuring machine, sending the first parameter and a device's identifier to the communication channel;
- acquiring the first parameter upon identifying the device's identifier on the communication channel;
- configuring the first parameter to the first device; and
- turning-off a feature to configure the first device until the first device is in an un-configured state;
- wherein the first device is embedded in a second device and provides administrative capabilities to the second device.

The examiner relies on the following references:

Philippou et al.	(Philippou)	6,385,648	May 7, 2002
		(filed	Nov. 2, 1998)
Ylonen		6,782,474	Aug. 24, 2004
		(filed	Jun. 4, 1999)

The following rejection is on appeal before us:

1. Claims 1-7, 9, 10 and 12-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Philippou in view of Ylonen [answer, page 7].

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the briefs have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii)(2004). See also In re Watts, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

It is our view, after consideration of the record before us that the evidence relied upon by the examiner does not support the examiner's rejection of claims 1-7, 9, 10 and 12-23. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. 277 F3d. at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's

conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

We consider the examiner's rejection of claims 1, 16 and 19 as being unpatentable over the teachings of Philippou in view of Ylonen [answer, page 4]. Since appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will select independent claim 1 as the representative claim for this rejection because it is the broadest independent claim. See 37 C.F.R. § 1.37(c)(1)(vii)(2004).

Appellants argue that the examiner has failed to provide a proper motivation for modifying the teachings of Philippou with the teachings of Ylonen that is found in either the references themselves or in the common knowledge of one of ordinary skill in the art [brief, page 11]. Appellants acknowledge that Ylonen teaches a method for loading configuration data into a network device in a reliable manner [brief, page 11; see also Ylonen col. 2, lines 58-63]. Appellants argue that the examiner's proffered motivation for modifying the teachings of Philippou with the teachings of Ylonen is presented as a general conclusory statement without supporting evidence [brief, page 11]. Appellants conclude that the examiner has failed to set forth a proper prima facie case of obviousness [*id.*].

The examiner disagrees [answer, page 10]. The examiner points out that Philippou and Ylonen are taken from the same field of endeavor [as the instant invention], noting that Philippou is related to initializing devices over

a network and Ylonen is related to installing network devices [answer, page 10].

At the outset, we note that to reach a proper conclusion under § 103, the examiner, as finder of fact, must step backward in time and into the mind of a person of ordinary skill in the art at a time when the invention was unknown, and just before it was made. In light of all the evidence, we review the specific factual determinations of the examiner to ascertain whether the examiner has convincingly established that the claimed invention as a whole would have been obvious at the time of the invention to a person of ordinary skill in the art. When claim elements are found in more than one prior art reference, the fact finder must determine “whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.” In re Kahn 441 F.3d at 988, 78 USPQ2d at 1337. With respect to the role of the examiner as finder of fact, the Court of Appeals for the Federal Circuit has stated: “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” In re Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444.

In the instant case, we note that the examiner acknowledges that Philippou fails to teach “turning-off a feature to configure the first device

until the first device is in an un-configured state,” as claimed [answer, page 5; claim 1]. We note that in the rejection the examiner proffers that an artisan would have been motivated to modify the teachings of Philippou with Ylonen’s teaching of disabling listening for configuration packets after configuration because “configuration data can be loaded in a reliable manner” [answer, page 5; see also Ylonen, col. 8, lines 66 and 67, cont’d col. 9, lines 1-9]. After careful consideration of all the evidence before us, we acknowledge that both Philippou and Ylonen are analogous art taken from the same field of endeavor as the instant invention (i.e., configuring network devices). We further note that the examiner has taken the proffered motivation to modify Philippou directly from the Ylonen reference, at col. 2, lines 58-63:

It is therefore desirable to provide a method and apparatus for loading configuration data into the network device in a reliable, easy-to-use manner from a network management station controlled by an employee skilled in configuration of new network devices [emphasis added].

Nevertheless, we agree with appellants that the examiner has failed to present a convincing line of reasoning as to why the artisan having knowledge of Philippou would have found the claimed invention to have been obvious in light of the teachings of Ylonen. In particular, we note that the examiner’s proffered motivation of loading configuration data in a reliable manner has a weak nexus with the teaching for which Ylonen is being

applied, namely, disabling listening for configuration packets after configuration [answer, page 5; see also Ylonen, col. 8, lines 66 and 67, cont'd col. 9, lines 1-9]. Significantly, we note that there is no explicit or implicit deficiency found within Philippou's disclosure that would suggest to an artisan that a more reliable manner of loading configuration data was required. Indeed, we note that Philippou is silent with respect to any mention of configuration reliability problems. Therefore, we do not see how an artisan having knowledge of Philippou would have been reasonably motivated to look to Ylonen to disable listening for configuration packets after configuration to achieve the purpose of loading configuration data in a reliable manner. We note that our reviewing court has clearly stated: "[d]etermination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor." ATD Corp. v. Lydall, Inc., 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998).

In the instant case, we find that the examiner has impermissibly used the claimed invention as a template or guide in order to piece together the

teachings of Philippon and Ylonen in an effort to create a mosaic of such prior art to argue obviousness. Therefore, we agree with appellants that the examiner has failed to meet his/her burden of presenting a prima facie case of obviousness. Accordingly, we will reverse the examiner's rejection of representative claim 1. Because independent claims 15, 16 and 19 contain limitations similar to claim 1, we will also reverse the examiner's rejection of these claims for the same reasons discussed supra with respect to representative claim 1. Because we have reversed the examiner's rejection of each independent claim, we will not sustain the examiner's rejection of any dependent claims under appeal.

In summary, we have not sustained the examiner's rejection of any claims under appeal. Therefore, the decision of the examiner rejecting claims 1-7, 9, 10 and 12-23 is reversed.

REVERSED.


Kenneth W. Hairston
Administrative Patent Judge


Jerry Smith
Administrative Patent Judge


Joseph F. Ruggiero
Administrative Patent Judge

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins CO 80527-2400